

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE S. HOWARD, L. JOY GRIEBENOW,
and KIM LINGER

Appeal No. 2002-2139
Application 09/456,647

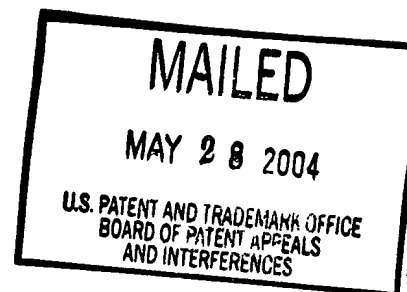
ON BRIEF

Before KRASS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 7, 8 and 24-26, which constitute all the claims remaining in the application. An amendment after final rejection was filed on April 12, 2001 but was denied entry by the examiner.



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The disclosed invention pertains to a method and apparatus for customizing advertising in an electronic publication. More particularly, the invention seeks to present specific advertising items to a user of the electronic publication based on the user's access to specific items within the electronic publication.

Representative claims 7 and 8 are reproduced as follows:

7. A method for advertising in an electronic publication, comprising:

creating an electronic publication which includes at least one content item and at least one advertising item;

permitting a user to access the electronic publication; and

presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic publication has been in use.

8. A method for customizing advertising in an electronic publication, comprising:

creating an electronic publication which includes a plurality of content items and at least one advertising item;

permitting a user to access the electronic publication; and

presenting the advertising item to the user of the electronic publication in response to the access of a specific content item.

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The examiner relies on the following reference:

Reilly et al. (Reilly) 5,740,549 Apr. 14, 1998

Claims 7, 8 and 24-26 stand rejected under 35 U.S.C.
§ 102(e) as being anticipated by the disclosure of Reilly.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Reilly does not fully meet the invention as set forth in claims 7 and 24-26. We reach the opposite conclusion with respect to claim 8. Accordingly, we affirm-in-part.

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Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the claimed invention to be anticipated by the disclosure of Reilly [answer, pages 3-5]. With respect to independent claim 8, appellants argue that Reilly does not provide the capability to link any given advertising item to any particular content item that has been accessed by the user [brief, pages 12-15]. The examiner responds that when claim 8 is given its broadest reasonable interpretation, it is met by the displaying of an advertisement to the user when the user accesses a news item [answer, page 6]. Appellants respond that claim 8 requires that a specific advertising item be presented in response to the access of a particular content item. They argue that the examiner's broadest reasonable interpretation is, in fact, not reasonable because the

examiner has read a limitation of claim 8 out of the claim [reply brief].

We will sustain the examiner's rejection of claim 8. In our view, appellants' argument that claim 8 requires the presenting of a specific advertisement associated with a specific content item is not commensurate with the scope of claim 8. The reference to "the advertising item" in line 7 of claim 8 is hard to define because it refers back to the phrase "at least one advertising item" in line 4. If there are a plurality of advertising items, then the claim recitation of "the advertising item" fails to identify a specific item from the plurality of items. The claim only makes clear sense if it is read to mean that one of the at least one advertising items is presented to the user in response to the access of a specific content item. Reilly clearly teaches that an advertising item from among a plurality of advertising items is presented to the user in response to the access of a specific content item. Therefore, we find that Reilly fully meets the invention of claim 8 when it is given its broadest reasonable interpretation.

With respect to dependent claim 26, appellants additionally argue that Reilly does not disclose any link between any advertising item and a portion of any content item that has

been accessed by the user [brief, pages 12-15]. The examiner responds that clicking on the category button in Reilly constitutes accessing a part of the specific content of the item [answer, pages 6-7]. Appellants respond that a category in Reilly is not a part of a news item. In fact, appellants note that a category in Reilly contains multiple news items, and therefore, a news item is part of a category rather than vice versa. Appellants also argue that the examiner has read distinctive limitations out of claim 26 [reply brief].

We will not sustain the examiner's rejection of claim 26 for essentially the reasons argued by appellants in the briefs. On the record before us, the examiner has failed to identify a "predetermined part of the specific content item" in Reilly which makes sense. As argued by appellants, the content button of Reilly cannot be a predetermined part of the specific content item as the latter item has been defined by the examiner in meeting claim 8.

With respect to independent claim 7 and dependent claim 24, appellants argue that Reilly does not provide a particular advertising item to the user based on the amount of time that the electronic publication has been in use [brief, pages 17-19]. The examiner responds that Reilly clearly discloses presenting the

advertisement item to the user at a predetermined time interval [answer, page 7]. Appellants respond that the examiner's broadest reasonable interpretation of claim 7 is, in fact, not reasonable [reply brief].

We will not sustain the examiner's rejection of claims 7 and 24 for essentially the reasons argued by appellants in the briefs. We agree with appellants that a proper interpretation of claim 7 requires that a measurement of the amount of time that the electronic publication has been in use be maintained. The predetermined time periods of Reilly have nothing to do with the amount of time that the electronic publication of Reilly has been in use. As argued by appellants, the predetermined time periods in Reilly only relate to the amount of time that a particular advertisement has been presented to the user.


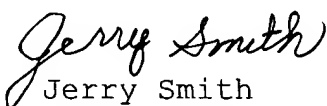

Since claim 25 depends from claim 7, we also do not sustain the examiner's rejection of claim 25 for the reasons just discussed. We also note for the record that claim 25 would have been separately patentable on this record based on appellants' arguments regarding the setting of the predetermined amount of time as a function of the maintained information. Reilly does not disclose this additional feature.

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In summary, we have sustained the examiner's rejection with respect to claim 8, but we have not sustained the examiner's rejection with respect to claims 7 and 24-26. Therefore, the decision of the examiner rejecting claims 7, 8 and 24-26 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


Errol A. Krass)
Administrative Patent Judge)
)

Jerry Smith)
Administrative Patent Judge)
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Michael R. Fleming)
Administrative Patent Judge)

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